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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,461	12/12/2003	Bonnie M. Pemberton	31960.0104	9697
7590	09/25/2006		EXAMINER	
Schlutz & Associates, P.C. 5400 LBJ Freeway Dallas, TX 75240				OSELE, MARK A
		ART UNIT	PAPER NUMBER	1734

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/734,461	PEMBERTON ET AL.
	<b>Examiner</b> Mark A. Osele	<b>Art Unit</b> 1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 September 2006.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,7-15,42-45 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,42-45 and 47 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
- 1.) Certified copies of the priority documents have been received.
- 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Hoogstoel et al. (U.S. Patent 2,744,624). Hoogstoel et al. shows an article comprising a substantially rigid (column 2, lines 39-44) corrugated substrate, 22; a strip, 21, having a first adhesive surface and a second adhesive surface, the strip releasably adhered to the corrugated substrate on the first adhesive surface; and a release layer, 20, adhered on the second adhesive surface (Fig. 4; column 4, lines 33-51).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590156 (Avery Adhesive Label Corp.) in view of Bode (U.S. Patent 2,096,389), Avery Dennison (Avery Index Maker packaging), and Kriozere (U.S. Patent 4,348,440), and Ittershagen et al. (U.S. Patent 5,168,831). Avery Adhesive shows the

construction of double-sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See Figs. 1, 3).

Bode shows a plurality of continuous, unperforated double sided adhesive elements, 21-26, releasably adhered to and arranged side-by-side on a planar, unperforated transfer sheet, 20 (Fig. 4). Bode teaches that this arrangement can be preferable to individual double sided elements on a backing sheet (Figs. 1-3) because it makes for simple and economical handling and shipment of the elements (Page 2, left column, lines 12-14). Bode further teaches that the elements can be of any desired shape (Fig. 4; Page 2, left column, lines 14-18). In addition, Avery Dennison shows packaging of adhesive elements on a backing sheet by placing a plurality of rectangular adhesive elements side-by-side and parallel to the length of the elements on a planar unperforated transfer sheet. Similar to the adhesive elements of Bode, the adhesive elements of Avery Dennison are spaced from each other and from the side of the transfer sheet by gaps. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the double-sided adhesive tapes of Avery Adhesive Label Corp. on a continuous, unperforated, planar transfer sheet such as those of Bode and Avery Dennison because Bode teaches this arrangement to be economical for handling and shipping of double sided adhesive elements and Avery Dennison shows that this arrangement is conventional for shipping and marketing of adhesive elements.

Bode shows that it is helpful to provide a slit, 16, along the centerline of an unperforated backing sheet, 10, on an adhesive element, 11, 12, 13, so that the edges

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of the element are not damaged by force required on the edge when removing a backing sheet without a slit (Page 1, right column, lines 40-55). Kriozere shows that the backing sheet, 16, 18, of a rectangular adhesive element, 12, is slit along the central longitudinal axis, 20, to aid in alignment of the strip (column 1, line 65 to column 2, line 6). A similar slit along the center perpendicular to the longitudinal axis would not be as desirable because a user typically requires alignment of the long side of a rectangular article, such as when applying masking tape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements of the references as combined above because Bode teaches this location for a slit prevents damage to the peripheral edges and Kriozere shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

Ittershagen et al. teaches that one use for double sided adhesive tapes is to prevent an animal from touching an undesired region. This is accomplished by making the adhesive layers transparent (column 3, lines 1-6, 10-13, 62-68) and making the top adhesive of a tack strength sufficient to cause a releasable sticking sensation to the animal (column 1, lines 17-20; column 3, lines 21-30) and the bottom adhesive layer capable of being releasably adhered to home furnishings (column 2, lines 14-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the double-sided adhesive element of the references as combined above transparent and with tack strength to releasably adhere to an animal because

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Ittershagen et al. teaches the benefits of these adhesive materials in preventing an animal from touching undesired regions.

5. Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogstoel et al. (U.S. Patent 2,744,624). As shown in paragraph 2 above, Hoogstoel et al. shows the instantly claimed product except for the material of the substrate. Hoogstoel et al. teaches that the substrate can comprise any desired material flexible or rigid material (column 2, lines 30-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the substrate of Hoogstoel et al. of plastic because plastic is an inexpensive, conventional material for corrugated materials.

Regarding claim 44, Hoogstoel et al. shows the substrate to be made of a material such as kraft paper, which is the color of many soils. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use kraft paper or a similarly colored plastic as the substrate because Hoogstoel et al. shows substrates of this color to be acceptable for adhesive coated, corrugated articles.

6. Claims 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogstoel et al. in view of Bode and Kriozere. As shown in paragraph 2 above, Hoogstoel et al. shows the instantly claimed product except for the release layer to comprise two separately removable portions. Bode shows that it is helpful to provide a slit, 16, along the centerline of an unperforated backing sheet, 10, on an adhesive

element, 11, 12, 13, so that the edges of the element are not damaged by force required on the edge when removing a backing sheet without a slit (Page 1, right column, lines 40-55). Kriozere shows that the backing sheet, 16, 18, of a rectangular adhesive element, 12, is slit along the central longitudinal axis, 20, to aid in alignment of the strip (column 1, line 65 to column 2, line 6). A similar slit along the center perpendicular to the longitudinal axis would not be as desirable because a user typically requires alignment of the long side of a rectangular article, such as when applying masking tape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements of Hoogstoel et al. because Bode teaches this location for a slit prevents damage to the peripheral edges and Kriozere shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

Regarding claim 47, Hoogstoel et al. shows a plurality of adhesive strips, 21, placed side-by-side on the corrugated substrate, 22, separated by a gap having a width which is a substantial fraction of the width of the strips (Fig. 4).

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 45 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not include the newly claimed subject matter that a plurality of strips are placed side by side on a corrugated substrate separated by a gap having a width which is a substantial fraction of the width of the strips. The two full paragraphs of page 6 of the instant specification and Fig. 4 of the instant application each show a corrugated substrate with only one strip of adhesive, not a plurality placed side by side.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-3, 42-45, and 47 have been considered but are moot in view of the new ground(s) of rejection.
  
10. Furthermore, the evidence of secondary considerations submitted September 11, 2006 have not been of sufficient influence to overcome the obviousness rejections. Applicant's conclude that applicant's increase in market share arises from advances in the art developed for applicant's product release in 1996; those advances currently being claimed. Applicant's remarks suggest that the Declaration of Bonnie Pemberton shows the claimed invention was a replacement of the prior art. The cited declaration actually suggests that the only other known double-sided adhesive tape on the market prior to 1996 was in a roll sold by the 3-M Company. There is no evidence presented suggesting that this roll sold by 3-M had any instruction on using the tape to prevent

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cats from clawing furniture. This being the case, the declaration does not in fact state that the invention was a replacement of the prior art, but rather implies a repackaging and remarketing of a previous product.

When the declaration further states, "With the appearance of similar products, our market share has grown from 0% to almost 80% in less than 10 years," does this market include all double-sided adhesive tapes, including the rolled adhesive tape of 3-M or only double-sided adhesive tapes marketed at cat owners for scratch prevention? The declaration is unclear and therefore not persuasive. If applicant's market share is determined on only those products directed toward cat owners, then the possibility arises that the increase in sales is due to marketing and advertising directed at cat owners. An important factor in determining the market success attributable to product improvements would be whether the double-sided adhesive tape roll of 3-M was sold in pet stores prior to 1996. Presumably this tape has been sold in hardware stores and arts and crafts stores, but was it ever placed in a way to attract cat owners for its specific use as a cat deterrent? If not, then it is equally likely that the increase in sales is a result of marketing, packaging, and perhaps advertising. The packaging and marketing of a plurality of adhesive elements on a flat transfer sheet have been shown by Bode and Avery Dennison in paragraph 4 above. Without more conclusive evidence, the showings of commercial success are not persuasive.

Applicant also includes evidence of positive comments of the product made by cat experts. These citations could also be related to the packaging of the product which has been discussed above. One of the pieces of evidence requires specific analysis.

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The ASPCA Seal of Approval states that "3% of the sales of the product will directly benefit ASPCA national humane programs." There is no evidence that this seal of approval was not a quid pro quo for the monetary percentage given to the ASPCA.

Finally, the evidence that competitors have copied applicant's product, instructions, and packaging has been considered. The totality of evidence presented by applicant was weighed against the prior art products as well as the cited teachings and suggestions for altering the prior art. The conclusion reached from careful consideration of the evidence is that the instantly claimed invention would have been obvious to one of ordinary skill in the art.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nelson and Morita each show corrugated substrates coated with an adhesive on one side for holding an object to the substrate.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**MARK A. OSELE  
PRIMARY EXAMINER**

September 22, 2006